IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s):	Alex Dai-Shun Poon	Examiner: Sanjeev Malhotra	
Serial No.:	09/491,703	Group Art Unit: 3667	
Filed:	January 26, 2000	Docket No.: 2043.007US1	
Customer No.:	49845	Confirmation No.: 8953	
Title:	METHOD AND APPARATUS FOR FACILITATING USER SELECTION OF A CATEGORY ITEM IN A TRANSACTION		

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. 41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Examiner's Answer mailed January 31, 2013, please consider the remarks contained herein.

REMARKS

1. *The Examiner falsely stated that Appellants failed to recognize the findings set forth in the Appeal Board Decision dated September 27, 2011*

The Examiner stated that "Appellant has failed to recognize the findings of fact already concluded by the BAPI in its decision mailed out on September 27, 2011."[1] The Examiner is wrong. In fact, in response to the Final Office Action dated March 26, 2008 (hereinafter "*First Final Office Action*") and the Appeal Decision dated September 27, 2011 (hereinafter "*Appeal Board Decision*"), Appellants noted the following:

> According to the Appeal Board, "the Examiner correctly characterized the scope and content of Greef in finding that it discloses the claim limitation 'providing a category number associated with said selected category entry to be displayed for said user in said display window.'"[2] However, *Greef* does not disclose "based on said receiving of said category number from said user, providing category information corresponding to said category number," much less category information that "enable[s] said selection of said subcategory entry of said subcategory field to be displayed without requiring another selection by said user of said category entry of said category field and another selection by said user of said subcategory entry of said at least one subcategory field," as recited in each of amended independent claims 9, 21, and 41.[3]

Therefore, starting with the *First Final Office Action Response*, Appellants acknowledged the finding of the Appeal Board with respect to the recitation of "providing a category number associated with said selected category entry to be displayed for said user in said display window." Appellants further noted that *Greef* does not disclose ***other*** elements of each of the

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[1] Examiner's Answer dated January 31, 2013 (hereinafter "*Examiner's Answer*"), at 10-11.

[2] *Appeal Board Decision* at 5.

[3] Final Office Action Response filed on November 28, 2011 (hereinafter "*First Final Office Action Response*").

independent claims that were added after the *Appeal Board Decision*. In fact, as will be explained in more detail below, in the amendments submitted by Appellants after the *Appeal Board Decision*, Appellants carefully considered the findings of the Board. Therefore, the Examiner's statement that Appellants failed to recognize the findings of the Board as set forth in the *Appeal Board Decision* is false.

2. *The* Appeal Board Decision *does not support the Examiner's rejection of independent claims 9, 25, and 41 as amended by Appellants after the* Appeal Board Decision

The Examiner cited to various portions of the *Appeal Board Decision* in support of his rejection of claims 9, 14, 15, 25, 30, 31, 41, 46, and 47 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,397,221 to Greef et al. (hereinafter "*Greef*") and in view of Official Notice by the Examiner "for a transaction to take place."[4] However, in the *Appeal Board Decision*, the Board made two findings, neither of which supports the Examiner's assertion that *Greef*, in combination with the Official Notice taken by the Examiner, teaches or suggests all of the elements of each of independent claims 9, 25, and 41 as amended by Appellants after the *Appeal Board Decision* (i.e., in the *First Final Office Action Response* and in the Non-Final Office Action Response filed on May 4, 2012 (hereinafter "*Non-Final Office Action Response*")).

First, the Board made the following finding:

> [T]he Examiner correctly characterized the scope and content of Greef in finding that it discloses the claim limitation "responding to said detection of said selection of said category entry, providing a plurality of subcategory entries being hierarchically related to said selected category entry within a category hierarchy data structure, to be hierarchically displayed for said user in at least one subcategory field within said display window, concurrently with said category field, said plurality of subcategory entries being used to categorize said item in said transaction."

[4] *See Examiner's Answer* at 11-12.

Appellants did not contest this finding by the Board.[5] Instead, Appellants asserted that no combination of *Greef* and Official Notice taken by the Examiner teaches or suggests ***other*** elements of independent claims 9, 25, and 41 submitted by Appellants after the *Appeal Board Decision*.[6]

For example, Appellants asserted that "*Greef* does not teach or suggest 'receiving a specification of a category number that uniquely identifies a combination of [a] category entry and [a] subcategory entry,' much less 'receiving an additional specification of said category number,' and 'based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window,' as recited in each of independent claims 9, 25, and 41.[7] Instead, Appellants asserted, "*Greef* merely discusses 'enabl[ing] the user to select a tabular product attribute to act as general identifier for products in the hierarchical frame structure.'"[8]

Additionally, Appellants asserted that "*Greef* teaches away from the elements of independent claims 9, 25, and 41 *Greef* teaches away from, at least, 'receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry, 'receiving an additional specification of said category number,' and 'based on said receiving of, said additional specification of said category number automatically reselecting said category and said subcategory in said display window,' as recited in each of independent claims 9, 25, and 41."[9]

The Board did not address these assertions in the *Appeal Board Decision*.[10] Furthermore, the Examiner did not address, at least, the assertion by Appellants that *Greef* teaches away from

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[5] *See Appeal Brief* at 1-20.

[6] *See Appeal Brief* at 11-12.

[7] *Appeal Brief* at 11-12.

[8] *Id.* at 12.

[9] *Appeal Brief* at 12-13.

[10] *See Appeal Board Decision* at 1-8.

the elements of each of independent claims 9, 25, and 41, as amended after the *Appeal Board Decision*.

Second, the Board made the following finding:

> Thus, the claim term "category number" is reasonably broadly construed as covering a number. Greefs "model number" is also a number. Accordingly, we see no error in the Examiner's position that the term "category number" as used in the claim reads on Greef's "model number."[11]

Again, Appellants did not contest this finding by the Board.[12] Instead, Appellants made the following assertion:

> *Greef* merely discusses 'enabl[ing] the user to select a tabular product attribute to act as general identifier for products in the hierarchical frame structure.' As an example of one such tabular attribute, *Greef* discusses a 'model number.' However, *Greef* does not teach or suggest that the 'model number' (or any such tabular attribute for a product) 'uniquely identifies a combination of a category entry and a subcategory entry,' much less 'receiving a specification of [said] category number' and 'automatically reselecting said category and said subcategory in [a] display window . . . based on [a] receiving of an additional specification of said category number,' as recited in each of independent claims 9, 25, and 41."[13]

In other words, Appellants did not dispute the Board's finding that "the term 'category number' as used in the claim reads on Greef's 'model number.'"[14] Instead, Appellants asserted that the mere disclosure in *Greef* of a number that reads on a "category number" does not teach or suggest using that number to "uniquely identif[y] a combination of a category entry and a subcategory entry" or "reselecting said category and said subcategory in [a] display window . . .

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[11] *Appeal Board Decision* at 6-7

[12] *See Appeal Brief* at 1-20.

[13] *Appeal Brief* at 12 (citations omitted).

[14] *Appeal Board Decision* at 6.

based on [a] receiving of an additional specification of said category number," as recited in each of claims 9, 25, and 41, as amended after the *Appeal Board Decision*.

For the above reasons, the *Appeal Board Decision* does not does not support the Examiner's rejection under 35 U.S.C. § 103(a) of independent claims 9, 25, and 41, and their respective dependent claims, as amended after the *Appeal Board Decision*.

3. The finality of the Final Office Action dated June 29, 2012 was improper because the Examiner raised new grounds of rejection that were not necessitated by the Non-Final Office Action Response filed on May 4, 2012

MPEP § 706.07(a) states the following:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). MPEP § 706.07(a).[15]

In the Non-Final Office Action dated January 4, 2012 (hereinafter "*Non-Final Office Action*"), the Examiner cited solely to *Greef* in support of his allegation that claims 9, 11-15, 25, 27-31, 41, and 43-47 are unpatentable under 35 U.S.C. § 103(a).[16]

In the Non-Final Office Action Response filed on May 4, 2012 (hereinafter "*Non-Final Office Action Response*"), Appellants made amendments to the claims that were unrelated to the inclusion of the recitation of the term "transaction" in each of independent claims 9, 25, and 41.

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[15] MPEP § 706.07(a).

[16] *Non-Final Office Action* at 2.

In the Final Office Action dated June 29, 2012 (hereinafter "*Second Final Office Action*"), the Examiner maintained the rejection set forth in the *Non-Final Office Action*, but added new grounds of rejection. In particular, the Examiner took Official Notice "for a transaction to take place."[17] The Examiner also conceded that "Greef might not expressly disclose a transaction," but stated that "since this is an e-commerce shopping system and method, a transaction is obviously present."[18]

This new ground of rejection set forth in the *Second Final Office Action* was not necessitated by amendments made by Appellants in the *Non-Final Office Action Response*. Therefore, the finality of the Office Action was improper.

Additionally, in the "Response to Arguments" section of the *Second Final Office Action* response, the Examiner cited to U.S. Patent Application Publication No. 2005/0071251A1 to Linden (hereinafter "*Linden*") as allegedly supporting the rejection of each of independent claims 9, 25, and 41.[19] However, the Examiner did not point to any portion of *Linden* in either the *Non-Final Office Action* or the *Second Final Office Action* as allegedly teaching or suggesting any element of independent claims 9, 25, and 41. Instead, the Examiner merely cited to *Linden* as allegedly teaching or suggesting elements of claims 16, 32, 48, 71, 73, and 75.[20]

If the Examiner's reference to *Linden* pertains to any element that was recited in claims 9, 25, and 41 previous to the *Non-Final Office Action Response*, which is likely given the scope of the amendments made by Appellants in the *Non-Final Office Action Response*, then the Examiner's reference to *Linden* is an additional new ground of rejection that renders the finality of the rejection improper.

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[17] *Second Final office Action* at 3-4.

[18] *Second Final Office Action* at 6-7.

[19] *Second Final Office Action* at 9-10.

[20] *Second Final Office Action* at 7.

4. *The new grounds of rejection improperly cited by the Examiner in the* Second Final Office Action *do not cure the deficiencies of* Greef *with respect to the elements of the independent claims*

As explained in the Appeal Brief filed January 2, 2013 (hereinafter "*Appeal Brief*"), the Official Notice "for a transaction to place" and the teachings of the *Linden* reference do not cure the deficiencies of *Greef* with respect to, at least, the elements of independent claims 9, 25, and 41 that were added by amendment after the *Appeal Board Decision*.[21] Thus, *Greef*, *Linden*, and the Official Notice, whether viewed individually or in combination, do not teach or suggest all of the elements of independent claims 9, 25, and 41, and their respective dependent claims.

5. *The Examiner falsely stated that "Appellant did not properly traverse the use of the Official Notice taken by the Examiner"*

The Examiner alleged that "Appellant did not properly traverse the use of the Official Notice taken by the Examiner."[22] Appellants respectfully disagree. As described above, the Examiner first raised the grounds of Official Notice in the *Second Final Office Action*. Appellants addressed the Examiner's addition of the grounds of Official Notice in all of the subsequent responses, including the Pre-Appeal Brief filed on October 1, 2012,[23] and the *Appeal Brief*.[24] Accordingly, Appellants properly traversed the Examiner's rejection under 35 U.S.C. § 103(a) of each of independent claims 9, 25, and 41, and their respective dependent claims, over *Greef* in view of Official Notice.

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[21] *See Appeal Brief* at 13-15.

[22] Examiner's Answer at 12.

[23] *Pre-Appeal Brief* at 2.

[24] *Appeal Brief* at 14.

CONCLUSION

For the above reasons, it is respectfully submitted that the art cited does not render the claims obvious and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claims are respectfully requested.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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